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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,030	09/11/2003	Kathryn E. Foster	H 50017 HST	5806

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EXAMINER	
DELCOTTO, GREGORY R	

ART UNIT	PAPER NUMBER
1751	

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/660,030	FOSTER, KATHRYN E.	
	Examiner	Art Unit	
	Gregory R. Del Cotto	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) *15 and 16* is/are withdrawn from consideration.

5)☒ Claim(s) *11-14* is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-16* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10-03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-16 are pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-14, drawn to a coating removal composition, classified in class 510, subclass 201.

II. Claims 15 and 16, drawn, classified in class 134, subclass 38.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the composition of Group I can be used in a materially different process such as in a method of cleaning textiles.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mary Cameron on February 8, 2005, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15 and 16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-8 are rejected under 35 U.S.C. 102(a) as being anticipated by WO02/053802. Note that, WO02/053802 also qualifies as prior art under 35 USC 102(e).

'802 teaches paint residues may be removed from spraying equipment and the like by flushing with aqueous compositions containing alkoxylated aromatic alcohols wherein the aromatic ring moieties of such alcohols do not bear any alkyl substituent containing more than 4 carbon atoms. Preferably, the compositions also contain an alkanolamine or other base. See Abstract. Preferred aromatic alcohols include triethylene glycol monophenyl ether, tetraethylene glycol monophenyl ether, etc.

Suitable alkoxylated aromatic alcohols are available from commercial sources such as Harcross (T Det P4), Clariant (ST-8329), and Genapol BA04. See page 4, lines 15-28. Suitable alkanolamines include diethanolamine, triethanolamine, monoethanolamine, etc., and examples of suitable inorganic bases include alkali metal hydroxides, alkali metal carbonates, alkali metal silicates, alkali metal phosphates, etc. In one embodiment of the invention, an alkanolamine is used in combination with an alkali metal silicate See page 7, lines 20-34. In general, the content of water is not more than 10% by weight of th composition. In a working solution, the alkoxylated aromatic alcohol and alkanolamine component may be present in varying amounts. See page 10, lines 1-12. '802 discloses the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the broad teachings of '802 anticipate the material limitations of the instant claims.

Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilson (US 2002/0144718) or Wilson (US 2004/0002437).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Wilson teaches paint residues may be removed from spraying equipment and the like by flushing with aqueous compositions containing alkoxylated aromatic alcohols wherein the aromatic ring moieties of such alcohols do not bear any alkyl substituent containing more than 4 carbon atoms. Preferably, the compositions also contain an alkanolamine or other base. See Abstract. Preferred aromatic alcohols include triethylene glycol monophenyl ether, tetraethylene glycol monophenyl ether, etc. Suitable alkoxylated aromatic alcohols are available from commercial sources such as Harcross (T Det P4), Clariant (ST-8329), and Genapol BA04. See para. 15. Suitable alkanolamines include diethanolamine, triethanolamine, monoethanolamine, etc., and examples of suitable inorganic bases include alkali metal hydroxides, alkali metal carbonates, alkali metal silicates, alkali metal phosphates, etc. In one embodiment of the invention, an alkanolamine is used in combination with an alkali metal silicate See para. 35. In general, the content of water is not more than 10% by weight of the composition. In a working solution, the alkoxylated aromatic alcohol and alkanolamine component may be present in varying amounts. See para. 42. '802 discloses the claimed invention with sufficient specificity to constitute anticipation.

'437 teaches a flushing solution containing a solvent component, an alkaline source, and a corrosion inhibitor component. See Abstract. Specifically, '437 teaches a flushing solution containing one or more alkoxylated aromatic alcohols each of which contains at least one aromatic ring and alkoxylate units, an alkaline source, an aliphatic phosphate ester, and a buffering agent. The alkaline source is selected from inorganic bases, alkanolamine, amines, and mixtures thereof. See claims 16-18. Note that, '437

teaches the same alkoxylated aromatic solvents as recited by the instant claims. See claims 21-23. Preferably inorganic bases include sodium hydroxide or ammonia. See para. 7. The flushing solutions not including the amount of water, contain from about 50% to about 99% by weight of the organic solvent component, from about 0.% to about 25% by weight of the alkaline source, etc. See para. 23. To prepare a working flushing solution, the concentrate is diluted to about 2% to about 10% by volume of water. See para 56. '437 discloses the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the broad teachings of '437 anticipate the material limitations of the instant claims.

Claims 1-3, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Figdore et al (US 6,001,793).

Figdore et al teach a cleaning composition for removing soils from a substrate. These compositions contain at least on higher terpene hydrocarbon solvent, at least one surfactant, at least one metal corrosion inhibiting agent, at least one hard surface stress crazing inhibiting agent, and water. See Abstract. Suitable nonionic surfactants include condensation products of alkyl phenols having an alkyl group containing from 6 to 12 carbon atoms and 5 to 25 moles of ethylene oxide, etc. see column 3, lines 30-60. Suitable anti-corrosion agents include mono-, di-, or tri- ethanolamine, etc. See column 4, lines 25-40. The amount of surfactant ranges from 1 to about 40% by weight of the composition and the amount of corrosion inhibiting agent ranges from 0.01 to 10 parts by weight of the composition. See column 5, lines 8-20.

Specifically, Figdore et al teach a composition containing 4% nonyl phenol ethoxylate, 4.92% potassium hydroxide (45%), 0.5% triethanolamine, water, etc. See column 8, lines 1-25. Figdore et al disclose the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teaching of Figdore et al anticipate the material limitations of the instant claims.

Claims 1-3, 5, and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seaman, Jr. (US 4,978,469).

Seaman, Jr. teaches a cleaning compositions containing about 20 to 70% water, 0.5 to 20% nonionic surfactant, 0.5 to 15% alkaline compound, 10 to 60% of ethylene glycol, etc., 0.5 to 20% of ethanol, etc., 0 to 10% of a hardness compound, 0 to 1% of a silicone based defoamer, and 0 to 1% dye. See column 1, lines 37-45 and claim 1. Suitable alkaline compounds include sodium and potassium hydroxide, monoethanolamine, etc. See column 3, lines 55-62. Suitable nonionic surfactants include a nonylphenol ethoxylate having an average of 9.5 ethoxy units. See column 4, lines 35-50.

Seaman, Jr. does not teach, with sufficient specificity, a composition containing water, an alkoxylated aromatic alcohol, an inorganic base, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition containing water, an alkoxylated

aromatic alcohol, an inorganic base, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of Seaman, Jr. suggest a composition containing water, an alkoxylated aromatic alcohol, an inorganic base, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27, 29-32, and 36-39 of copending Application No. 10/871,258, claims 1-15 and 63-93 of 10/183662, and claims 21, 23-31, and 34-36 of 10/027445 . Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 27, 29-32, and 36-39 of copending Application No. 10/871,258, claims 1-15 and 63-93 of 10/183662,

and claims 21, 23-31, and 34-36 of 10/027445 encompass the material limitations of the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition containing water, an alkoxylated aromatic alcohol, an inorganic base, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because claims 27, 29-32, and 36-39 of copending Application No. 10/871,258, claims 1-15 and 63-93 of 10/183662, and claims 21, 23-31, and 34-36 of 10/027445 suggest a composition containing water, an alkoxylated aromatic alcohol, an inorganic base, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

Claims 11-14 are allowed.

None of the references of record, alone or in combination, teach or suggest a concentrate having two separately packaged parts to be combined containing the specific components as recited by the instant claims.

Conclusion

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.

Applicant is reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory R. Del Cotto

Primary Examiner
Art Unit 1751

GRD
April 16, 2005